



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/354,802	07/16/1999	RICHARD MARC LIBMAN	2176.0010003	5598

26111 7590 02/02/2004

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

AKERS, GEOFFREY R

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/357802

Applicant(s)

Libman

Examiner

Akers, G

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/16/04
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-21, 23-31, 33-315 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-21, 23-31, 33-315 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

1. This action is issued in reply to applicant's Request for Continued Examination(RCE)(Paper # 24 and Amendment D(Paper #25) filed 1/16/04.
2. Claims 1-3,36,38,43,47,49,271,311-315 were amended.
3. Claims 1-10,12-21,23-31,33-315 are pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 5.(AMENDED) Independent claims 1-3,36,38,43,47,49 are rejected under 35 USC 103(a) as unpatentable over Tobin(US Pat. No: 6,141,666) in view of Clark(US Pat. No:5,710,889) in view of Randle(US Pat. No: 5,787,403) in view of Horowitz(US Pat. No: 6,349,290) and further in view of Lewis(US Pat. No: 6,513,019).

- 6.(AMENDED) As per claims 1-3,36,38,43,47,49,51-315 Tobin teaches a method for automatically preparing a customized reply to each response communication from a plurality of clients(Abstract)(col 2 line 57-col 3 line 62)(col 5 line 1-col 6 line 19) where each response labeled to correspond to a labeled communication set to each of the

Art Unit: 3624

plurality of clients(Fig 8)(col 8 line 49-54) where the method comprises receiving a plurality of responses where each response comprises a unique label to identify each response as coming from a particular client(col 9 line 52-col 10 line 7) and each response comprises a non purchase response option information (Fig 7)(col 8 lines 25-40)(col 7 lines 12-31)(Fig 1C/114)(Fig 7/114) and inputting the response option information and corresponding client identification into an automated reply generation system(Fig 7/708) and preparing a reply specific to each response of the plurality of responses using the automated reply generation system where each reply comprises a label corresponding to the unique label of its corresponding response(Fig 7/115) and delivering prepared replies to the clients. In addition to that taught by Tobin, Clark teaches providing a diversity of financial services to consumers(Abstract)(Fig 15) as requested by the customer(Fig 16) as well as individualized selections(Fig 17)(Fig 18) as well as customized content in selections(Fig 19) as well as the user selecting criteria(Fig 27) and customized reports to clients(Fig 28).It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Clark to teach part of the above. The motivation to combine is to teach an electronic delivery system that provides a customer access to a variety of financial services as enunciated by Clark(col 2 lines 36-39).In addition to that taught by Clark, Randle teaches a banking services platform that enables a financial services institution to provide new services, as access to brokerage investment and information, commercial banking and loan reviews and applications and selections as well as other financial products from other institutions(col 4 lines 38-58) as well as the ability of the financial institution to create

Art Unit: 3624

customized and unique products particular to the institution available as products to the customers of the institution(col 5 lines 32-38).It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Clark and further in view of Randle to teach the above. The motivation to combine is to teach a bank-centric service platform that enables customers to utilize advanced technology in accessing financial services particular to the individualized customer needs as enunciated by Randle(col 1 lines 51-col 2 line 2).In addition to that taught by Randle, Horowitz teaches an automated interactive and proactive system for customized and personalized presentation of products of a financial institution in response to a request by a client(Abstract)(Fig 1-37)(col 1 line 65-col 3 line 40).In addition to that taught by Horowitz,Lewis teaches an integrated computer system that consolidates data, derives information from this data and distributes this information to users and software applications and a database that makes the information available for access by numerous customers according to selected inquiry and published criteria(col 8 line 49-col 9 line 2).Lewis further teaches the database content consisting of global market data, financial institutions, customers, accounts and product lines(col 11 lines 56-64)(Fig 2) and consolidation(col 2 lines 10-26). It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Clark in view of Randle and further in view of Horowitz to teach part of the invention. The motivation to combine is to teach an automated customization and personalized product service presentation system that utilizes intelligent engines that self learn and couple customer business needs with a financial institution's broadest set of products and services as

Art Unit: 3624

enunciated by Horowitz(col 2 lines 5-11). It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Clark in view of Randle in view of Horowitz and further in view of Lewis to teach the invention. The motivation to combine is to teach an integrated comprehensive information management system to provide market data(and consequently marketing data) to masses of customers as enunciated by Lewis (col 4 lines 37-43).

7. (AMENDED) As per claims 2,3,36,38,43,47,49,51-315 Tobin teaches a system for automatically preparing customized communications each of a plurality of clients where the communications present client response options including non purchase options(Abstract)(Fig 7/114)(col 8 lines 25-40) and replying to non purchase options from clients with customized replies where the method comprises using decision information to automatically select variable information about each client and inserting the client information into the client communication which includes client response options(Fig 7/102) and appending each client communication to a separate host communication to form a plurality of combine communications where each of the combined communications comprises a client identifying label(Fig 7/708) and where delivering each combine communication to a respective one of the plurality of clients(Fig 8) and receiving a plurality of responses where each response comprises an identifying label and response option information(Fig 11C/114)(Fig 18/1800) and inputting the response option information into each of the responses in a system for generating replies(Fig 12/115) and preparing a reply to each of the responses where each reply is directed to response option information and each reply comprises an identifying label

Art Unit: 3624

and(Fig 18) delivering the replies to the appropriate client(Fig 12/708).clients.In addition to that taught by Tobin, Clark teaches providing a diversity of financial services to consumers(Abstract)(Fig 15) as requested by the customer(Fig 16) as well as individualized selections(Fig 17)(Fig 18) as well as customized content in selections(Fig 19) as well as the user selecting criteria(Fig 27) and customized reports to clients(Fig 28).It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Clark to teach part of the above. The motivation to combine is to teach an electronic delivery system that provides a customer access to a variety of financial services as enunciated by Clark(col 2 lines 36-39).In addition to that taught by Clark, Randle teaches a banking services platform that enables a financial services institution to provide new services, as access to brokerage investment and information, commercial banking and loan reviews and applications and selections as well as other financial products from other institutions(col 4 lines 38-58) as well as the ability of the financial institution to create customized and unique products particular to the institution available as products to the customers of the institution(col 5 lines 32-38).It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Clark and further in view of Randle to teach the above. The motivation to combine is to teach a bank-centric service platform that enables customers to utilize advanced technology in accessing financial services particular to the individualized customer needs as enunciated by Randle(col 1 lines 51-col 2 line 2).In addition to that taught by Randle, Horowitz teaches an automated interactive and proactive system for customized and personalized presentation of products of a financial institution in

response to a request by a client(Abstract)(Fig 1-37)(col 1 line 65-col 3 line 40). In addition to that taught by Horowitz,Lewis teaches an integrated computer system that consolidates data, derives information from this data and distributes this information to users and software applications and a database that makes the information available for access by numerous customers according to selected inquiry and published criteria(col 8 line 49-col 9 line 2).Lewis further teaches the database content consisting of global market data, financial institutions, customers, accounts and product lines(col 11 lines 56-64)(Fig 2) and consolidation(col 2 lines 10-26). It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Clark in view of Randle and further in view of Horowitz to teach the invention. The motivation to combine is to teach an automated customization and personalized product service presentation system that utilizes intelligent engines that self learn and couple customer business needs with a financial institution's broadest set of products and services as enunciated by Horowitz(col 2 lines 5-11). It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Clark in view of Randle in view of Horowitz and further in view of Lewis to teach the invention. The motivation to combine is to teach an integrated comprehensive information management system to provide market data(and consequently marketing data) to masses of customers as enunciated by Lewis (col 4 lines 37-43).

8. Dependent claims 4-35,37,39-42,44-46,48,50-315 are rejected under 35 USC 103(a) as unpatentable over Tobin(US Pat. No:6,141,666) in view of Atkins(US Pat. No:

5,852,811)in view of Clark(US Pat. No:5,710,889) in view of Randle(US Pat. No: 5,787,403) in view of Horowitz(US Pat. No. 6,349,290) and further in view of Lewis(US Pat. No:6,513,019).

9.(AMENDED) As per claims 4-35,37,39-42,44-46,48,50-315 Tobin teaches a method for automatically preparing a customized reply to each response communication from a plurality of clients(Abstract)(col 2 line 57-col 3 line 62)(col 5 line 1-col 6 line 19) where each response labeled to correspond to a labeled communication set to each of the plurality of clients(Fig 8)(col 8 line 49-54) where the method comprises receiving a plurality of responses where each response comprises a unique label to identify each response as coming from a particular client(col 9 line 52-col 10 line 7). Tobin does not specifically teach the method of claim 1 wherein the labeled computer communication comprises information about a financial product utilizing the internet.In addition to that taught by Tobin, Atkins teaches this(Abstract)(Fig 3)(col 3 line 6-col 5 line 60)(col 6 lines 53-59)(col 20 lin 24-col 23 line 51)(Table 14)(col 24 lines 13-34)(col 34 line 28-col 36 line 45)(Fig 8a/8b/8c)(col 42 line 21-col 44 line 48).It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Atkins to teach the above. The motivation to combine is to provide a method to meet the wide variety of individual financial resources and attitudes toward financial investments and risk and to produce financial products tailored and customized to the current needs of individuals and be flexible to accommodate future variations in their requirements as enunciated by Atkins(col 2 lines 49-53).In addition to that taught by Atkins,Clark teaches providing a diversity of financial services to consumers(Abstract)(Fig 15) as requested by the

Art Unit: 3624

customer(Fig 16) as well as individualized selections(Fig 17)(Fig 18) as well as customized content in selections(Fig 19) as well as the user selecting criteria(Fig 27) and customized reports to clients(Fig 28).It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Atkins in view of Clark to teach part of the above. The motivation to combine is to teach an electronic delivery system that provides a customer access to a variety of financial services as enunciated by Clark(col 2 lines 36-39).In addition to that taught by Clark, Randle teaches a banking services platform that enables a financial services institution to provide new services, as access to brokerage investment and information, commercial banking and loan reviews and applications and selections as well as other financial products from other institutions(col 4 lines 38-58) as well as the ability of the financial institution to create customized and unique products particular to the institution available as products to the customers of the institution(col 5 lines 32-38).It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Atkins in view of Clark and further in view of Randle to teach the above. The motivation to combine is to teach a bank-centric service platform that enables customers to utilize advanced technology in accessing financial services particular to the individualized customer needs as enunciated by Randle(col 1 lines 51-col 2 line 2).In addition to that taught by Randle, Horowitz teaches an automated interactive and proactive system for customized and personalized presentation of products of a financial institution in response to a request by a client(Abstract)(Fig 1-37)(col 1 line 65-col 3 line 40).In addition to that taught by Horowitz, Lewis teaches an integrated computer system that consolidates data, derives

Art Unit: 3624

information from this data and distributes this information to users and software applications and a database that makes the information available for access by numerous customers according to selected inquiry and published criteria(col 8 line 49-col 9 line 2).Lewis further teaches the database content consisting of global market data, financial institutions, customers, accounts and product lines(col 11 lines 56-64)(Fig 2) and consolidation(col 2 lines 10-26). It would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Atkins in view of Clark in view of Randle and further in view of Horowitz to teach the invention. The motivation to combine is to teach an automated customization and personalized product service presentation system that utilizes intelligent engines that self learn and couple customer business needs with a financial institution's broadest set of products and services as enunciated by Horowitz(col 2 lines 5-11). It also would have been obvious to one skilled in the art at the time of the invention to combine Tobin in view of Atkins in view of Clark in view of Randle in view of Horowitz and further in view of Lewis to teach the invention. The motivation to combine is to teach an integrated comprehensive information management system to provide market data(and consequently marketing data) to masses of customers as enunciated by Lewis (col 4 lines 37-43).

Double Patenting

9. Claims 1-315 are further rejected under the judicially created doctrine of double patenting over the claim of U. S. Patent No. 5,987,434 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: US Pat. No: 5,987,434 contain substantially similar claims and subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant has stated (page 58/paper #25) a Terminal Disclaimer will be filed at a later date.

Response to Arguments

10. Applicant's arguments with respect to claims 1-10, 12-21, 23-31, 33-315 have been considered but are moot in view of the necessitated additional (new) ground(s) of rejection.

Conclusion

11. THIS ACTION IS MADE NON-FINAL.

Questions concerning this communication should be addressed to the examiner of record, Dr. Geoffrey Akers, P.E., who can be reached between 6:30 AM and 5:00 PM Monday through Friday at 703-306-5844. If examiner cannot be reached, the superior, Mr. Vincent Millin, SPE, may be telephoned at (703)-308-1065.

GRA



DR. GEOFFREY R. AKERS, P.E.
PRIMARY EXAMINER